## REMARKS

Claims **1-20** are pending.  Reconsideration and timely withdrawal of the pending rejections are requested for the reasons discussed below.

### *35 U.S.C. § 102(e) Rejection*

Claims 1-4 and 9-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,704,871 to KAPLAN et al.  Applicant respectfully traverses this rejection.

The Examiner asserted that KAPLAN discloses all the features recited in these claims including, among other features, a combinational logic comprising logic functions whose outputs depend solely on their inputs and utilizing logic circuits without memory.

Applicant respectfully disagrees.  Notwithstanding the Office Action assertions as to what KAPLAN discloses, Applicant submits that KAPLAN fails to disclose, or even suggest at least the features of claims 1, 16 and 19.

In particular, independent claims 1, 16 and 19 recite:

the combinational logic comprising logic functions whose outputs depend solely on their inputs and utilizing logic circuits without memory

Applicant does not dispute that KAPLAN discloses a cryptographic co-processor having cryptographic function elements (see Abstract).  However, the Examiner is not correct that KAPLAN teaches a combinational logic comprising logic functions whose outputs depend solely on their inputs and utilizing logic circuits without memory.

While the Examiner has identified col. 10, lines 26-44 of KAPLAN as teaching

this feature, this language merely states the following:

> The Secure Hash Block is tightly coupled with the Encrypt Block and provides
> hardware accelerated one-way Hash functions. Both the MD-5 and SHAD-1
> algorithms are supported. Combined operations which chain both Hashing and
> Encrypt/Decrypt functions are provided in order to significantly reduce the
> processing time for data which needs both operations applied. For Hash-then-
> Encrypt and Hash-then-Decrypt operations, the CryptIC can perform parallel
> execution of both functions from the same source and destination buffers. For
> Encrypt-then-Hash and Decrypt-then-Hash operations, the processing must be
> sequential, however minimum latency is still provided through the pipeline
> chaining design. An Offset may be specified between the start of Hashing and
> the start of Encryption to support certain protocols such as IPsec, and `Mutable
> bit` handling is provided in hardware.

While such language discusses parallel execution and sequential processing of

Encrypt-then-Hash and Decrypt-then-Hash operations, such language is silent with

regard to a combinational logic comprising logic functions whose outputs depend solely

on their inputs and utilizing logic circuits without memory. (claims 1, 16 and 19).

Furthermore, to the extent that the Examiner is basing the instant rejection on an

argument of inherency consistent with MPEP 2112, Applicant notes that MPEP 2112

specifically states, in part:

> "In relying upon the theory of inherency, the examiner must provide a basis in
> fact and/or technical reasoning to reasonably support the determination that the
> allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the
> applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter.
> 1990) (emphasis in original) (Applicant's invention was directed to a biaxially
> oriented, flexible dilation catheter balloon (a tube which expands upon inflation)
> used, for example, in clearing the blood vessels of heart patients). The examiner
> applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular
> preform and then injecting air into the preform to expand it against a mold (blow
> molding). The reference did not directly state that the end product balloon was

biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Thus, Applicant submits that independent claims 1, 16 and 19 are not anticipated by any proper reading of KAPLAN.

Furthermore, Applicant submits that dependent claims 2-4, 9-15, 17, 18 and 20 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(e).

***35 U.S.C. § 103 Rejection***

Claims 5-8 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over KAPLAN in view of US Patent No. 6,192,129 to COPPERSMITH et al. This rejection is respectfully traversed.

The Examiner acknowledges that KAPLAN fails to disclose, among other things, the features recited in the above-noted dependent claims. However, the Examiner explains that such features are taught in COPPERSMITH, and that it would have been obvious to combine the teachings of these documents. Applicant respectfully submits that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

In addition to the arguments noted above regarding KAPLAN, Applicant submits that this rejection is improper at least because COPPERSMITH is not available prior art against the instant application based on 35 U.S.C. § 103(c). The Examiner's attention is directed to MPEP 2146.

As the Examiner knows, the instant Application claims the benefit of the U.S. filing date of January 26, 2001. Moreover, COPPERSMITH issued on February 20, 2001 (after January 26, 2001). As such, COPPERSMITH is a 35 U.S.C. § 102(e) reference. Furthermore, both the instant application and the COPPERSMITH were commonly owned (by IBM) at the time that the instant application was filed.

Accordingly, pursuant to 35 U.S.C. § 103(c) and MPEP 2146, Applicant submits that the instant rejection is improper under 35 U.S.C. § 103(a).

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

## CONCLUSION

In view of the foregoing remarks, Applicant submits that all of the claims are

patentably distinct from the prior art of record and are in condition for allowance. The

Examiner is invited to contact the undersigned at the telephone number listed below, if

needed.  Please charge any deficiencies in fees and credit any overpayment of fees to

**IBM Deposit Account 09-0457**.

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Respectfully submitted,
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